

31 member and to conform at least the flexible strap member to a portion of the surface of the snowboarding boot, said flexible strap member including a pocket which is configured and arranged to movably receive a first end of the first strap member therein.

REMARKS

Applicants thank the Examiner for the telephone conference of February 5, 2003. The substance of the telephone conference is summarized below.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 36-50 are allowed. Applicants also note that claims 3, 4, 15, 16, 25, 29, 58, 59, 61, 66, 72, 73, 81, 91, 92, 99, and 100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. However, Applicants have not rewritten these claims because Applicants believe that the claims upon which these claims depend are allowable.

Rejection under 35 U.S.C. §112

Claims 97-104 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, claim 97 is rejected because "the strap" lacks antecedent basis. As discussed during the telephone conference, Claim 97 has been amended by changing "strap" to "apparatus" to overcome the rejection. Accordingly, withdrawal of the rejection of claims 97-104 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Rejections Under 35 U.S.C. §103

I. Rejection Based on Hansen in View of Breuer

Claims 1, 2, 5-14, 17-24, 26-28, 56, 57, 60, 62-65, 67-71, 74-80, 82-90, 93-98, and 101-104 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Patent No. 5,918,897) in view of Breuer (DE 44 16 024). Applicants respectfully request reconsideration.

A. *Hansen Teaches Away from the Combination*

Applicants respectfully submit that combination of Hansen and Breuer is improper because Hansen teaches away from the combination. MPEP 2144.05 states "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." As discussed with the Examiner, Hansen emphasizes that his invention advantageously eliminates buckles such as the one described by Breuer. Specifically, in Hansen's binding, a "complicated threading of straps or toothed belts into locking buckles is unnecessary." (column 2, lines 58-60) Thus Hansen specifically highlights the fact that his binding does not contain toothed belts and locking buckles. Therefore, applicants respectfully submit that Hansen explicitly teaches away from combining the toothed belt/locking buckle of Breuer with the binding of Hansen. The Examiner concurred with this analysis.

B. *Combination Would be Unsatisfactory for its Intended Purpose*

Although not discussed with the Examiner, Applicants also submit that the proposed combination is improper because the combination would be unsatisfactory for its intended purpose. According to MPEP 2143.01, "if [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Hansen specifically states that one advantage of his binding is that it is continuously adjustable. He states, "Both adjustments are thus possible continuously rather than step-by-step." (column 4, lines 66-67) In contrast, Breuer teaches using a locking buckle with a toothed strap. The toothed strap catches the locking buckle at discrete locations in order to retain the strap at a desired position. Thus, combining Hansen with Breuer would necessarily result in "step-by-step" adjustments, instead of the continuous adjustability Hansen promoted.

Therefore, Applicants respectfully submit that a *prima facie* case has not been presented because there is no motivation to combine Hansen with Breuer. Specifically, Hansen teaches away from the proposed combination and the combination would result in an invention which would be unsatisfactory for Hansen's intended purpose. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection Based on Hansen in View of Breuer and Andre

Claims 23, 24, 26, 27, 28, 56, 57, 60, 62-65, 67-71, 74-80, 82-84, and 87 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Patent No. 5,918,897) in view of Breuer (DE 44 16 024) and Andre (U.S. patent 2,531,763). Specifically, Andre is relied upon to teach a mounting system which includes a plurality of apertures and a mating fastener. This rejection is also respectfully traversed and Applicants respectfully request reconsideration.

A. *Combination Would be Unsatisfactory for its Intended Purpose*

The combination of Hansen, Breuer, and Andre is improper because it would frustrate the purpose of Hansen. As discussed with the Examiner, Hansen teaches a rear-entry binding, where the highback is rotated down in order to allow insertion of a boot. Therefore, a user simply slides a boot into the binding and rotates the highback portion up in order to secure the boot into the binding. Thus, one stated objective of Hansen is to provide a preset closure position for the instep portion, so that the instep portion will be the correct size each time the boot is placed in the binding. Hansen states that other bindings disadvantageously must be adjusted after every use. (column 1, lines 42-45) Additionally, the only stated object of Hansen's invention is to "improve the snowboard binding ... such that getting into and out of it is considerably simplified and that a *predefined* closure position of all elements of the binding is reassumed with very little effort after every closure of the binding." (column 1, lines 53-57, emphasis added) Thus Hansen emphasized the goal of providing a binding with a preset closure position.

Andre teaches a hook and aperture system, where a user places his foot into the boot and secures a hook into one of several predefined holes. The continuous tension between the hook and hole, provided by the user's leg, retains the hook in the desired hole. As discussed, if a hook were placed into one of the holes in Andre without providing tension between the hook and hole, the hook would fall out of the desired hole. Likewise, if one were to put the hook system taught by Andre into the binding of Hansen, the binding would not be able to provide a preset closure position. When there is no boot in the binding, there would be no tension between the hook and the hole, and thus the hook would tend to disengage from the desired hole. Therefore, a user would have to readjust this portion of the binding after each insertion, thus frustrating one of Hansen's stated purposes. The Examiner concurred with this analysis.

Thus, because substituting the hook/aperture system of Andre for the closure system of Hansen would frustrate Hansen's purpose of providing a preset closure position, Applicants submit that a *prima facie* case of obviousness has not been presented. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

Carpenter et al., Applicants

By: 

Neil P. Ferraro, Reg. No. 39,188
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2211
Tel. No.: (617) 720-3500

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MARKED-UP CLAIMS

Claim 97 has been amended as follows:

97. (Amended) An apparatus for engaging a snowboarding boot, the [strap] apparatus being securable to a first strap member and further being releasably connectable to a second strap member, the [strap] apparatus comprising:

a flexible strap member configured and arranged to be connected to the second strap member to adjust the relative positions of the flexible strap member and the second strap member and to conform at least the flexible strap member to a portion of the surface of the snowboarding boot, said flexible strap member including a pocket which is configured and arranged to movably receive a first end of the first strap member therein.